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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,127

09/25/2006

Akio Sugihara

Q97391

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65565

7590

08/25/2009

SUGHRUE-265550

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EXAMINER

RAHMANI, NILOOFAR

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

08/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,127	Applicant(s) SUGIHARA ET AL.	
	Examiner NILOOFAR RAHMANI	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on remark dated on 06/16/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,12 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,12 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/09/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 10, 12 and 17 are pending and claims 1-9, 11, and 13-16 are cancelled in the instant application.

2. ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10, 12 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 10, 12 and 17 are drawn to pharmaceutical composition of solifenacin or a salt thereof for use in a solid formulation, the composition containing crystalline and amorphous solifenacin or a crystalline and amorphous salt thereof, together with an inhibitor of an amorphous preparation, wherein the inhibitor of an amorphous preparation is a substance having an ethylene oxide chain and wherein the crystalline and amorphous solifenacin or a crystalline and amorphous salt thereof is not in contact with or in mixture with the inhibitor of an amorphous preparation, which has no antecedent basis in the specification.

This is a NEW MATTER rejection. Removal of all new matter is required, In re Russmussen 210 USPQ 325.

If the new matter will be removed from claim 10, then the following rejection will be maintained.

3. The rejection of claims 10, 12 and 17 under obvious-type double patenting over the claims 1-13 of Umejima et al., US 2008/0103171 is maintained. Applicants defer responding to the rejection and respectfully request that the rejection be held in abeyance. It is examiner's position that the rejection will be maintained for the reason of record.

4. The rejection of claims 10, 12 and 17 under 35 U.S.C. 102(e) over Slatter et al., US 2004/0138253 is maintained. Applicants argue that the amended claims are not anticipated by the cited references. It is examiner's position that Slatter et al. disclosed the instant claimed composition. The form of composition is silent in the prior art. Therefore, the solid form of the composition is inherently there.

5. The rejection of claims 10, 12 and 17 under 35 U.S.C. 102(e) over Fraser et al., US 2004/0198822 is maintained. Applicants argue that the amended claims are not anticipated by the cited references. It is examiner's position that Fraser et al. disclosed the instant claimed composition. The form of composition is silent in the prior art. Therefore, the solid form of the composition is inherently there.

6. The rejection of claims 10, 12 and 17 under 35 U.S.C. 102(e) over Saito et al., US 2005/0181031 is maintained. Applicants argue that the amended claims are not anticipated by the cited references. It is examiner's position that Saito et al. disclosed the instant claimed composition. The form of composition is silent in the prior art. Therefore, the solid form of the composition is inherently there.

7. The rejection of claims 10, 12 and 17 under 35 U.S.C. 102(e) over Fraser et al., US 2005/0239890 is maintained. Applicants argue that the amended claims are not anticipated by the cited references. It is examiner's position that Fraser et al. disclosed the instant claimed composition. The form of composition is silent in the prior art. Therefore, the solid form of the composition is inherently there.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/NILOOFAR RAHMANI/

08/18/2009

/D. Margaret Seaman/

Primary Examiner, Art Unit 1625